

REMARKS

Claims 1-146 were pending prior to the Office Action. By this amendment, claims 49-146 are canceled without disclaimer or prejudice; claims 1-3 and 25-27 are amended; and new claims 147-173 are added. Support for amendments and additions can be found, for example, in paragraphs [0028], [0040], [0065]-[0068] and [0200]-[0209] of the specification as filed, and related discussions throughout the specification. No new matter has been added. Thus, claims 1-48 and 147-173 are now pending. In view of the above amendments and the following remarks, reconsideration and allowance of this application is respectfully requested.

A. Claim Rejections Under 35 U.S.C. § 103

1. 103(a) Rejections with Regard to Wyman

Claims 1-2, 4-15, 17-26, 28-39, 41-52, 54-66, 68-87, 89-101 and 103-146 stand rejected under 35 U.S.C. § 103(a) over Wyman, U.S. Patent No. 5,438,508 (“Wyman”). Of these, claims 1-2, 4-15, 17-26, 28-39 and 41-48 are now pending. In view of the amendments above and the comments below, Applicants respectfully request reconsideration and withdrawal of these rejections.

In particular, the claimed invention relates to a system and method for controlling use of an item. Rights expressions may be used by publishers to designate a complex set of usage rights to apply to a given product or system. The claimed invention provides a systemic method by which a stakeholder can control the usage rights to digital works or other items based on dynamic conditions.

For example, claim 1, as amended, recites:

1. A computer-implemented method for controlling use of an item, said method comprising:
 - specifying, by a provider of an item, a computer-readable rights expression, wherein said rights expression indicates a manner of use of said item by a recipient of said item and a condition for use of said item by said recipient, said condition indicating that said use of said item by said recipient is subject to an authorization by a stakeholder;
 - associating said rights expression with said item;

receiving a request, at a repository computing device, for use of said item from said recipient;
granting by said stakeholder said authorization for use of said item by said recipient, in accordance with said condition; and
controlling said repository computing device by said stakeholder to thereby control said use of said item by said recipient based on said rights expression and said authorization granted by said stakeholder.

In addition, claim 25, as amended, recites:

25. A computer-implemented system for controlling use of an item, said system comprising:
means for specifying, by a provider of an item, a computer-readable rights expression, wherein said rights expression indicates a manner of use of said item by a recipient of said item and a condition for use of said item by said recipient, said condition indicating that said use of said item by said recipient is subject to an authorization by a stakeholder;
means for associating said rights expression with said item;
means for receiving a request, at a repository computing device, for use of said item from said recipient;
means for granting by said stakeholder said authorization for use of said item by said recipient, in accordance with said condition; and
means for controlling said repository computing device by said stakeholder to thereby control said use of said item by said recipient based on said rights expression and an authorization granted by said stakeholder.

Furthermore, new claim 149 recites:

149. A computer-readable medium including one or more computer-readable instructions embedded therein for controlling use of an item, said computer-readable instructions comprising:
instructions for specifying, by a provider of an item, a computer-readable rights expression, wherein said rights expression indicates a manner of use of said item by a recipient of said item and a condition for use of said item by said recipient, said condition indicating that said use of said item by said recipient is subject to an authorization by a stakeholder;
instructions for associating said rights expression with said item;
instructions for receiving a request, at a repository computing device, for use of said item from said recipient;
instructions for granting by said stakeholder said authorization for use of said item by said recipient, in accordance with said condition; and
instructions for controlling said repository computing device by said stakeholder to thereby control said use of said item by said recipient based on said rights expression and an authorization granted by said stakeholder.

In contrast, Wyman is directed to a method and apparatus for managing execution of licensed software items in a computer system, and fails to disclose, suggest, or render obvious the claimed invention. Instead, Wyman relies upon “personal use” licenses that limit “the

number of named users of a licensed product". (See Wyman, col. 20, lines 36-47). For example, Wyman discloses:

A "personal use" license is one that limits the number of named users of a licensed product. This style of licensing guarantees the members of a list of users access to a product. Associated with a personal use type of product use authorization there is a list of registered users. The administrator is able to assign these users as required up to the limit imposed by the product use authorization; the number of units assigned to each user is indicated by the LURDM. It may be a constant or it may vary as specified in a LURT. The context template is "user name", the duration is "assignment", and the policy is "allocative".

There is no suggestion whatsoever in Wyman that the licenses are further controlled by an authorization by a stakeholder, as is described in the claimed invention. For example, the Examiner's attention is directed to paragraph [0067] of the published application, which provides:

[0067] The exemplary embodiments include recognition that in Digital Rights Management typically the focus has been on giving the owners of content control over the content. Accordingly, the exemplary embodiments include recognition that other stakeholders exist and allow such other stakeholders to have a role in the management of digital rights. For example, such a role can include allowing exercise of control over the distribution and use of content by other stakeholders, for example, such as governments, parents, and the like. Advantageously, the exemplary embodiments allow governments, parents, and the like, to control or monitor or otherwise be involved in what content can be distributed and who can receive or use such content. In a further exemplary embodiment, the governments or parents, and the like, also can be allowed to control the terms under which such content can be distributed or used.

Thus, advantageously, a stakeholder can be specified to ensure that a recipient of an item can use the item in accordance with agreed manners of use or manners of use specified by applicable law or regulation, and the like. (Paragraph [0070] of the specification). Furthermore,

the stakeholder may exercise an additional level of control through a variety of functions. For example, paragraph [0076] of the specification provides:

[0076] In the exemplary embodiments, a specified condition of the right of the consumer to acquire, render or do something else with respect to an item can be the involvement of a stakeholder. In an exemplary embodiment, such involvement can include that approval is obtained from a specified stakeholder. However, in further exemplary embodiments, such involvement can include actions other than approval, such as that the stakeholder being allowed to track, audit or have some other role with respect to the item. For example, in the third exemplary use case, the government may not care what the editorial content of an e-book of a felon is as long as any fees for the sales thereof are collected in a way authorized by the government so that the victims can be paid. In an exemplary embodiment, the involvement of the government as a stakeholder might continue only for so long as it takes to compensate the victims in the appropriate amounts and thereafter the government can cease to be involved. Accordingly, in the exemplary embodiments, the involvement of a stakeholder can cease or can commence at any appropriate time.

Thus, for at least the above reasons, Wyman fails to disclose, suggest, or render obvious the invention recited in independent claims 1 and 25, as is required for a proper rejection under 35 U.S.C. § 103(a). Dependent claims 2, 4-15, 17-26, 28-39, and 41-48 are also believed to be patentable at least for the reasons discussed above with respect to claims 1 and 25 by virtue of their dependency thereon, and also on their own merits. Accordingly, Applicants respectfully request reconsideration and withdrawal of this rejection. Finally, Applicants respectfully submit that Wyman also fails to disclose, suggest, or render obvious new claim 149 and those claims dependent thereon.

2. 103(a) Rejections with Regard to Wyman in view of Terao et al.

Claims 3, 27, 53 and 88 stand rejected under 35 U.S.C. § 103(a) over Wyman in view of Terao et al., U.S. Patent No. 6,690,794 (“Terao”). Specifically, the Examiner asserts that Terao discloses digital tickets that reference rights expressions.

However, Applicants submit that neither of Wyman nor Terao, taken alone or in combination, disclose, suggest, or render obvious, the invention recited in the claims. In particular, Terao at least fails to overcome the above-stated deficiencies of Wyman. Accordingly, Applicants submit that the combined teachings of Wyman and Terao fail to disclose, suggest, or render obvious the invention recited in the claims. Thus, Applicants respectfully request reconsideration and withdrawal of this rejection.

While Applicants do not necessarily agree with the Examiner with respect to claims 53 and 88, the rejection of these claims is now moot in view of their cancellation herein, and should be withdrawn.

B. **Claim Rejections Under 35 U.S.C. § 101**

Claims 1-146 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. However, claims 1 and 25, as amended herein, are computer-implemented and integrate computing devices. Thus, amended claims 1 and 25 recite statutory subject matter under § 101 because each embodiment is “tied to a particular machine or apparatus.” *In re Bilski*, — F.3d — (Fed. Cir. 2008). Claims 2-24 and 26-48 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter because they are dependent on claims 1 and 25, respectively. Because amended claims 1 and 25 clearly comply with 35 U.S.C. § 101, Applicants respectfully request withdrawal of these rejections.

Claims 49-146 also stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. While Applicants do not necessarily agree with Examiner in this regard, this rejection is now moot in view of the cancellation of these claims herein, and should be withdrawn.

C. Claim Rejections Under 35 U.S.C. § 112

Claims 2-3, 26-27, 52-53, 87-88, 123 and 134 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the invention. The Examiner asserts that language like “permission” or “allowing” is indefinite because it appears to cover anything and everything that does not prohibit actions from occurring. Accordingly, Applicants have amended claims 2-3 and 26-27 to instead use the term “granting,” which Applicants believe fully satisfies 35 U.S.C. § 112, second paragraph. Thus, Applicants respectfully request reconsideration and withdrawal of this rejection.

While Applicants do not necessarily agree with the Examiner with respect to claims 52-53, 87-88, 123 and 134, the rejection of these claims is now moot in view of their cancellation herein, and should be withdrawn.

D. Allowable Subject Matter

Applicants acknowledge the Examiner’s indication of allowable subject matter with respect to claims 16, 40, 67 and 102, if rewritten into independent form. However, for the reasons advanced herein, it is respectfully submitted that all of the pending claims 1-48 and 147-173 are in condition for allowance, and a notice to that effect is respectfully requested.

E. Conclusion

In view of the foregoing, it is submitted that the present application is in condition for allowance and a notice to that effect is respectfully requested. If, however, the Examiner deems that any issue remains after considering this response, the Examiner is invited to contact the undersigned attorney to expedite the prosecution and engage in a joint effort to work out a mutually satisfactory solution.

Except for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required,

including any required extension of time fees, or credit any overpayment to Deposit Account No. 19-2380. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,
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